

REMARKS:

Claims 1-35 are currently pending in the subject Application.

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,076,080 to Morscheck et al. (hereinafter “*Morscheck*”) in view of U.S. Patent No. 6,014,644 to Erickson (hereinafter “*Erickson*”).

Applicant notes with thanks the Examiner’s response of 28 May 2009. Applicant further notes with thanks the Examiner’s withdrawal of the previous rejections of Claims 1-22 under 35 U.S.C. § 101.

Applicant respectfully submits that all of Applicant’s arguments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections.

I. Rejections Under 35 U.S.C. § 103

Claims 1-35 stand rejected under 35 U.S.C. § 103(a) over *Morscheck* in view of *Erickson*.

Applicant respectfully submits that Claims 1, 11, 23, and 35 in their current form contain unique and novel limitations that are not disclosed in *Morscheck* and *Erickson*, whether taken individually or in combination. Thus, Applicant respectfully traverses the Examiner’s obviousness rejection of Claims 1-35 under 35 U.S.C. § 103(a) over the proposed combination of *Morscheck* and *Erickson*, either individually or in combination.

In rejecting Claim 1, the Examiner states the following:

However, *Morscheck* ***does not explicitly disclose*** a global content directory which includes a plurality of classes; the documents comprise unique documents stored

in seller database (claim 3); classes comprise a plurality of document classes (claims 4, 12, 24); the classes comprise a plurality of product classes (claims 5, 13, 25). Morscheck does disclose a data menu (Figure 8) which includes commands to sort and find a data and show detail of an Order Log (col. 10, lines 61-66). Morscheck discloses a filter feature wherein the Order Log entries are filtered based on specific needs. The filter feature obtains a list of log entries based on some filtering criteria. (Col. 11, lines 2-11)

Erickson, on the other hand, teaches global content directory which includes a plurality of classes; the documents comprise unique documents stored in seller database (claim 3); classes comprise a plurality of document classes (claims 4, 12, 24); the classes comprise a plurality of product classes (claims 5, 13, 25) (col. 7, lines 14-17; col. 7, lines 50-52).

(28 May 2009, Final Office Action, page 3). (Emphasis added). Applicant thanks the Examiner for noting that *Morscheck* fails to disclose “***a global content directory including a plurality of classes***” as required by Claim 1. However, Applicant respectfully disagrees with the Examiner’s assertion that *Erickson* discloses this element or more specifically, that *Erickson* discloses “***a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class.***”

While the Examiner does not explicitly state that *Erickson* discloses “***a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class***” in the above-referenced portion of the Final Office Action, the Examiner further states the following regarding *Erickson*’s disclosure of this element of Claim 1:

Applicant remarks that "Erickson fails to disclose a storage medium stored therein a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class, at least one of the classes having one or more associated pointers that identify one or more of the one or more document repositories".

Examiner does not agree. The combination of Morscheck and Erickson teaches the recitation above, specifically Erickson. Erickson teaches a central database which is accessed via classifications or any other manner that allows easy access by a buyer or supplier to the information stored in the central database (col. 7, lines 14-17). The central database serves as a repository for useful information to locate goods or services of interest (col. 7, lines 65-67). Classification information

may also be submitted illustrating types or classes or services or goods provided by a particular company (col. 7, lines 50-52). Erickson teaches the linking products and services to a class which will help locate groups or classes of products or services available (col. 9, lines 47-49).

Such central database which is accessed via classification; central database which serves as a repository for useful information to locate goods or services of interest; classification information illustrates types or classes provided by a particular company; and linking products and services to a class which will help locate groups or classes of products or services available are considered a global content directory including a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class, at least one of the classes having one or more associated pointers that identify one or more of the one or more document repositories".

(28 May 2009, Final Office Action, pages 6-7). Applicant respectfully submits that while the Examiner asserts that *Erickson* discloses "***a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class,***" the Examiner fails to point out what portion of *Erickson* specifically discloses "***a plurality of classes organized in a hierarchy, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class.***" As such, it appears that the Examiner relies on column 7, lines 46-67 of the specification of *Erickson*, provided below, to provide this element:

Although the process of soliciting bids and collecting responses using the present is described in greater detail below, the process may be summarized as follows. Supplier **12** submits information to service provider **14** to be included in central database **16**. Such information may include, for example, company profile information describing the company. ***Classification information may also be submitted illustrating the types or classes of services or goods provided by a particular company.*** Additionally, supplier **12** may also submit ***information regarding the products, product lines, services, and the like offered by the supplier. Classification information for the products and/or services offered by a particular supplier may also be submitted.*** In short, supplier **12** may submit any information into central database **16** that would be helpful for a buyer in locating and selecting supplier **12**. In certain embodiments, it may be desirable to limit the type of information submitted by a supplier to a ***predefined set of fields*** in order to provide consistency and uniformity in central database **16**. In other embodiments, perhaps a ***selected set of information*** must be submitted with the option of submitting additional information as well. In the present invention, central database **16** serves as a repository for information useful in allowing buyer **10** to locate suppliers **12** that offer goods or services of interest.

(Emphasis added). Applicant respectfully submits that the portion of *Erickson* relied upon by the Examiner fails to disclose at least “*a plurality of classes organized in a hierarchy*, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class” as required by Claim 1. Applicant further respectfully submits that *Erickson* merely discloses, among other things, classification information that may illustrate the types or classes of services or goods provided by a supplier and makes a general mention of “information regarding the products, product lines, services, and the like offered by the supplier.” Nowhere does the portion of *Erickson* relied upon by the Examiner suggest that any of this classification information is arranged in any manner that suggests the existence of a plurality of classes *organized in a hierarchy*. Thus, as the Examiner fails to point to any specific disclosure of *Erickson* or *Morscheck* that discloses this element and does not offer any assertion that there is any suggestion to combine any of the teachings of *Erickson* and *Morscheck* to suggest that “*a plurality of classes organized in a hierarchy*, each class categorizing the documents and associated with one or more attributes of the documents categorized in the class” would be obvious given the disclosures of these two references, Applicant respectfully submits that a rejection under 35 U.S.C. § 103 may not be properly maintained. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. § 103 be withdrawn.

II. The Final Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Morscheck-Erickson* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Morscheck* or *Erickson*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law

based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “***ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.***” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “***factual findings made by Office personnel are the necessary underpinnings to establish obviousness.***” (*id.*). Further, “***Office personnel must provide an explanation to support an obviousness rejection*** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *Morscheck* and *Erickson*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson.” (28 May 2009 Final Office Action, Pages 3-4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to

establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Morscheck* and *Erickson*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious

to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Morscheck, Erickson and Applicants claimed invention would have been obvious to one of ordinary skill in the art*. The Office Action merely states that “in order to allow easy access to the information stored.” (28 May 2009 Final Office Action, Pages 4). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Morscheck, Erickson and Applicants claimed invention would have been obvious to one of ordinary skill in the art*. Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious*.” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit*.” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness*.”’ (KSR, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant's claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection and combination of Morscheck and Erickson to render obvious Applicant's claimed invention*. The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made the system, method and software of Morscheck, to include global content directory which includes a plurality of classes; documents comprise unique documents stored in seller database; classes comprise a plurality of document classes; the classes comprise a plurality of product classes, as taught by Erickson" and "in order to allow easy access to the information stored," *does not adequately provide clear articulation of the reasons why Applicant's claimed invention would have been obvious*. (28 May 2009 Final Office Action, Pages 3-4). In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obviousness rejection based on the proposed combination of *Morscheck* and *Erickson*, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines*.

III. Applicant's Claims are Patentable over the Proposed Morscheck-Erickson Combination

With respect to Claims 11, 23, and 35 these claims contain similar limitations and are thus, considered patentably distinguishable over the proposed combination of *Morscheck* and *Erickson* for at least the reasons discussed above in connection with Claim 1.

Furthermore, with respect to dependent claims 2-10, 12-22, and 24-34: Claims 2-10 depend from Claim 1; Claims 12-22 depend from Claim 11; and dependent Claims 24-34 depend from Claim 23 and are also considered patentably distinguishable over *Erickson*. Thus, dependent Claims 2-10, 12-22, and 24-34 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-35 are not rendered obvious by the proposed combination of *Morscheck* and *Erickson*. Applicant further respectfully submits that Claims 1-35 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-35 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-35 be allowed.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

17 July 2009
Date

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